compound to determine the effect of the compound on nuclear receptor transcription activity; Group III, claim 3, drawn to a method for modulating the sensitivity of a cell to a sex hormone comprising the step of stimulating in the cell the abundance of a nuclear receptor; Group IV, claim 4, drawn to a method for modulating androgen receptor-mediated transactivation activity in a cell; Group V, claim 5, drawn to a method for down regulating androgen receptor-mediated transactivation activity in a cell; Group VI, claims 6-8, drawn to a method for modulating estrogen receptor-mediated transactivation activity in cell; Group VII, claim 9, drawn to a method for down regulating TR2; Group VIII, claims 10-12, drawn to a method for screening a compound for treating androgen receptor-related diseases comprising exposing cells to the compound and determining the effect of the compound on TR2 or TR4 orphan receptor signaling pathway in the cells; and Group IX, claims 13-15, drawn to a method for screening a compound for treating estrogen receptor-related disease comprising exposing cells to the compound and determining the effect of the compound on TR2 orphan receptor signaling pathway in those cells.

In response, applicants elect Group I, claim 1, with traverse.

To be valid, a restriction requirement must establish that (1) the "inventions" are either independent or distinct, **and** (2) that examination of more than one of the "inventions" would constitute a burden to the Examiner. Applicants note that the restriction/election requirement does not provide sufficient basis to indicate that examination of more than one of the "inventions" would overly burden the Examiner. Groups I, II, III, IV, V, VI, VII, VIII, and IX are all related in that they are methods related to at least one of the orphan receptors, TR2, TR4,

or RXR. As discussed below, there is structural and functional equivalence between TR2, TR4, and RXR, and therefore, it would not be an undue burden to search the Groups together.

2. The Restriction Election also required restriction among the TR2, TR4, and RXR receptors in groups I, II, III, IV, and VIII. In response, applicants elect for examination TR4 with traverse. The Examiner has improperly attempted to restrict elements of the claims as separate inventions that at the most could be considered separate species. The Examiner states that this restriction is proper because no structural or functional properties are shared within the group of nuclear receptors (TR2, TR4, and RXR). Applicants respectfully point the Examiner at least to page 5 paragraph 0016; page 6, paragraph 0019; page 7, paragraph 0024, page 8, paragraph 0030, and page 23 paragraph 70, which show that TR2 and TR4 both modulate AR and ER. Furthermore, both TR2 and TR4 activity is modulated by AR and ER. As all three nuclear receptors are able to modulate transactivational activity, the Examiner has failed to identify the most common functional feature which is the ability to modulate the transactivational activity of AR and ER or have their transactivational activity modulated by AR and ER. Furthermore, as AR and ER can both interact with each nuclear receptor, for binding to take place there necessarily must be sequence (i.e. Structural) homology. Thus the Examiner is incorrect with the assertion that no structural or functional features are described, as the ability to be modulated by AR or ER is in itself both a functional and structural limitation that defines any group which is limited by one or more of the three nuclear receptors. For at least this reason applicants believe the Examiner has failed to establish why the nuclear receptors should be

viewed as separate inventions or how examination of all three receptors would overly burden the Examiner.

Favorable consideration of claims 1-12 is earnestly solicited.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of $210.00, representing the fee for a small entity under 37 C.F.R. § 1.17(a)(2) is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

10/16/03
Date